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IN THE
Supreme Court of the United States
OCTOBER TERM, 1965

No. 57

HAZELTINE RESEARCH, INC. and ROBERT REGIS,
Petitioners,

vs.

DAVID L. LADD, COMMISSIONER OF PATENTS,
Respondent.

BRIEF FOR PETITIONERS

I. OPINIONS BELOW

The Opinion of the Court below (R. 82) is reported at 340 F.2d 786. The Opinion of the District Court (R. 69A) is reported at 226 F.Supp. 459. The decision of the Board of Appeals of the United States Patent Office (R. 42A) is not officially reported.

II. JURISDICTION

The jurisdiction of this Court is invoked under Title 28 United States Code, Section 1254 (1) (62 Stat. 928) and Title 28 United States Code, Section 2101(c) (63 Stat. 104); and under Rule 22(3) of the Rules of this Court.

The Judgment of the Court below was entered November 25, 1964; the Petition herein was filed on February 18, 1965, and granted on April 5, 1965.

III. THE STATUTES INVOLVED

This Petition involves a consideration of the following statutes:

Title 35 U. S. Code, Section 102 (66 Stat. 797):

“§ 102. Conditions for patentability; novelty and loss of right to patent

“A person shall be entitled to a patent unless—

“(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant, or

“(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

“(c) he has abandoned the invention, or

“(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

“(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

“(f) he did not himself invent the subject matter sought to be patented, or

“(g) before the applicant's invention thereof the invention was made in this country by another

who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

Title 35 U.S. Code, Section 103 (66 Stat. 798):

"§ 103. Conditions for patentability; non-obvious subject matter

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

Title 35 U.S. Code, Section 122 (66 Stat. 801):

"§ 122. Confidential status of applications

"Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner."

Title 35 U.S. Code, Section 145 (66 Stat. 803):

"§ 145. Civil action to obtain patent

"An applicant dissatisfied with the decision of

the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant."

IV. QUESTION PRESENTED

The sole question presented is:

Whether a "copending patent",* which is maintained in secrecy in the Patent Office until it issues, is a part of the general fund of knowledge or "prior art", as that term is used in Title 35 United States Code, Section 103, as of its *filing date* or as of its *issue date*.

V. STATEMENT OF THE CASE

Petitioner Robert Regis (Regis), on December 23, 1957, filed an application for Letters Patent, Serial No. 704, 770, in the United States Patent Office (R. 7A-46A) for a Microwave Switch, which application was duly assigned to Petitioner Hazeltine Research, Inc. (Hazeltine) (R. 47A). All of the claims of that application were finally

* A "copending patent" is one *issued after* the filing date of a patent application or patent *sub judice* but based upon an application *filed before* the filing date of such patent application or patent.

rejected by the Patent Office Examiner (R. 23A) "as being unpatentable over" Wallace et al. Patent No. 2,822,526 (R. 54A) "in view of" Carlson Patent No. 2,491,644 (R. 50A) and that rejection was affirmed by the Patent Office Board of Appeals (R. 42A).

Seeking a review of the Patent Office decisions, Petitioners, under the provisions of Title 35 U.S. Code, Section 145 (*supra*, pp. 3-4), filed their Complaint in the District Court for the District of Columbia, (R. 1A) requesting a Judgment that the Court authorize and direct the Commissioner of Patents to issue Letters Patent to Regis on his invention as described and claimed in his application (R. 7A).

The subjects matter of the Regis patent application and the Wallace et al. and Carlson patents are technically complex but, fortunately, the issues raised on this Petition do not involve an understanding or even a consideration of such technical subjects matter. Respondent, in the Patent Office proceedings (R. 34A — 35A; 43A) and in the Courts below, did not contend that either of these two reference patents individually anticipates the Regis invention or precludes the grant of a patent thereon.* What the Respondent below contended was that, as an engineering matter, it was obvious to combine the teachings of the Wallace et al. and Carlson patents to produce the structure defined by the claims of the Regis application.

Petitioners' position is that the Wallace et al. patent, as a matter of law, is not competent evidence to show whether or not the combination suggested by Respondent

"* * * would have been obvious at the time the invention was made to a person having ordinary

*In the event that the Court should be interested in the technical subjects matter of the Regis application (R. 7A) and the Wallace et al. and Carlson patents, brief summaries of their respective disclosures are included in Appendix I to this Brief.

skill in the art to which said subject matter pertains. * * * (Title 35, U.S. Code, Section 103; *supra*, p. 3)

Petitioners' position is based on the fact that at the time Regis made his invention and filed a patent application thereon on December 23, 1957, (R. 7A) the Wallace et al. disclosure was contained solely in an application maintained in secrecy in the Patent Office in compliance with Title 35, U.S. Code, Section 122 (*supra*, p. 3). The Wallace et al. disclosure, prior to its issuance on February 4, 1958, (R. 54A) was not available to Regis or to other contemporary workers in the art. That is, it was not available

"* * * at the time the invention was made to a person having ordinary skill in the art. * * *" (Title 35, U.S. Code, Section 103; *supra*, p. 3)

The application for the Wallace et al. patent having been filed on March 24, 1954, (R. 54A) before Regis filed his application on December 23, 1957, but having first been made public when it issued on February 4, 1958, *after* Regis' filing date, is generally termed a "copending patent". This is consonant with the definition of the Trial Court (R. 70A; footnote 1).

VI. ARGUMENT

GENERAL

Respondent relied in the Courts below and relies here* solely on Title 35, U.S. Code, Section 103 (*supra*, p. 3) to support its contention that a copending patent is a part of the prior art as of its filing date and that, therefore, the Regis invention "would have been obvious" in the light of the disclosures of the Wallace et al. copending patent and the Carlson prior art patent and that Regis is not entitled to the grant of a patent. However, for a proper construction of this Section 103, it is necessary to

* Brief for Respondent in Opposition to the Petition (BR., p. 2)

consider also Section 102 (*supra*, pp. 2-3), to which reference is made in Section 103.

Section 102 of the Patent Act of 1952 (Title 35, U.S. Code 102; *supra*, pp. 2-3) contains the basic provisions of the Patent Laws setting forth the conditions precedent to the grant of a patent. That Section states that "A person shall be entitled to a patent unless" certain bars exist. Respondent, in the Courts below, did not contend that the grant of a patent to Regis is barred by any of the circumstances set forth in this Section.

It is submitted that (1) by the terms of the Patent Statutes as interpreted with the aid of their legislative history, (2) by straightforward logic, and (3) by the rules of simple fairness, a patent *issued after* the filing date of a patent application or patent *sub judice* but based upon an application *filed before* the filing date of such patent application or patent is not, as of its filing date, competent evidence of the "prior art" from which the quantum of newness or unobviousness of an asserted invention is to be measured to determine its patentability.

**POINT 1. BY THE TERMS OF THE PATENT STATUTES,
A COENDING PATENT IS NOT COMPETENT
EVIDENCE OF THE PRIOR ART AS OF ITS
FILING DATE**

Each of the subsections of Section 102 (*supra*, pp. 2-3) refers to "the invention" (i.e., the entire invention, not just some part of it) in the singular. This Section effectively bars a patent to an applicant if the evidence shows that "the invention" was not first invented by the applicant.

Section 103 (*supra*, p. 3) is effectively a caveat to Section 102. It sets forth the criteria for determining whether or not a claimed invention is patentable over a

group of prior patents or publications or both, no individual one of which discloses or describes "the invention", that is, *the entire invention*. Such prior patents and publications make up that general fund of knowledge available to those skilled workers in the art which is collectively referred to as the "prior art"—a term used in Section 103 but nowhere explicitly defined in the Patent Statutes. It is this "prior art" which is used as a yardstick in measuring the quantum of advance represented by an asserted invention to determine its patentability.

A helpful guide in the interpretation of Section 103 is found in the Report from the Committee on the Judiciary of the House of Representatives, House Report 1923, 82nd Congress, May 12, 1952. That Report, in referring to Section 103, states:

"Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. *An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent.* That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. *It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102.* If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented." (p. 7; emphasis added)

Here we have a definition of the term "prior art", that is, "meaning what was known before as described in section 102." However, this reference back to Section 102

can only be to subsection 102(a), both because that subsection is the only one referring to what "was known * * * before" and because the remaining subsections are inapplicable. For example, subsection 102(b) was recently held to have "nothing whatever to do" with Section 103 in *In re Foster* (CCPA, 1965) F.2d; 145 USPQ 166, 174*; subsection 102(c) recites as a bar only that the inventor has abandoned his invention; subsection 102(d) raises as a bar that "the invention was first patented * * * in a foreign country"; while subsection 102(f) refers to the situation in which the applicant did not himself invent the subject matter, that is, that he derived it from someone else.

For a definition of what "was known * * * before" under subsection 102(a), again the Committee Report (*supra*, p. 8) is instructive:

"Section 102 in paragraphs (a), (b), and (c) repeats the conditions in the existing law relating to novelty

*"Subsection (a) is the language of the existing law, recognizing that the interpretation by the courts excludes various kinds of private knowledge not known to the public. (p. 6)***

"Paragraphs (a), (b), and (c) are based on 35 U. S. C., 1946 ed. § 31 (R. S. 4886, amended (1) Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, (2) May 23, 1930, ch. 312, § 1, 46 Stat. 376, (3) Aug. 5, 1939, ch. 450, § 1, 53 Stat. 1212).

* The rationale of the Court's holding is set out in the Opinion as follows:

"The determination of unobviousness, however, relates to the determination of whether a patentable invention has been made. Whether there has been a *loss of right to a patent* [under Sec. 102b] on such invention is a distinct and separate issue, with which section 103 per se has nothing whatever to do. * * *" (Emphasis Court's)

** Quoted with approval in *Rem-Cru Titanium v. Watson* (D. D.C., 1957) 152 F. Supp. 282, 285.

"No change is made in these paragraphs other than that due to division into lettered paragraphs. *The interpretation by the courts of paragraph (a) as being more restricted than the actual language would suggest (for example, 'known' has been held to mean 'publicly known') is recognized but no change in the language is made at this time. Paragraph (a) together with section 104 contains the substance of Title 35 U.S.C. 1946 ed., § 72 (R.S. 4923.)*" (p. 17; emphasis added).

In brief, the Committee Report commentary on Section 103 equates the term "prior art" to "what was known before, as described in section 102". But, again, the Committee Report comment on Section 102 points out that "what was known before" refers to what was *publicly* known. It follows therefore, under the terms of the Statutes, the term "prior art" as used in Section 103 is confined to *prior public knowledge*.

The "interpretation by the Courts" that prior knowledge, referred to in Section 102, "excludes various kinds of private knowledge not known to the public", is found in an unbroken line of authorities. For example, in the early case of *Pennock and Sellers v. Dialogue* (1829) 27 U.S. 1, this Court said:

"By the very terms of the first section of our statute, the secretary of state is authorized to grant a patent to any citizen applying for the same, who shall allege that he has invented a new and useful art, machine, &c. &c. '*not known or used before the application*' * * *." (p. 18; emphasis Court's)

"We think, then, the true meaning must be, not known or used by the public, before the application * * *." (p. 19)

and referring to an earlier English Statute:

"* * * The use here referred to has always been understood to be a public use, * * *." (p. 20)

The same rule was enunciated by this Court in *Gayler et al. v. Wilder* (1850) 51 U.S. 477, in considering a case based upon the Patent Act of 1836, containing the same limitation upon the grant of a patent, that is, that the invention shall be "not known or used by others":

"The act of 1836, ch. 357, Sec. 6, authorizes a patent where the party has discovered or invented a new and useful improvement, 'not known or used by others before his discovery or invention' * * *. The clause in question qualifies the words before used and shows that *by knowledge and use the legislature meant knowledge and use existing in a manner accessible to the public.*" (pp. 496-497; emphasis added)

A more up-to-date statement of this same principle is found in *Minneapolis-Honeywell v. Midwestern Instruments* (E.D. Ill., 1960) 188 F.Supp. 248, 250, 252 (affirmed (C.A. 7, 1961) 298 F.2d 36, 38). In that case, it was urged by defendant that certain work carried on for the Government and having a security classification was a part of the prior art. In holding to the contrary and finding the patent in suit valid, the Trial Court said:

"* * * The invention must cover something new (35 U.S.C. § 101) which is not in prior (35 U.S.C. § 102) *public* (*Rem-Cru Titanium, Inc. v. Robert C. Watson, Commissioner of Patents*, 152 F.Supp. 282, (D.C. 1957); *Block v. Nathan Anklet Support Co., Inc.*, 9 F.2d 311 (2nd Cir. 1925); *Gayler et al. v. Wilder*, 10 How. (51 U.S.) 476 1850) *knowledge*."* (p. 250, f.n. 3; emphasis added)

* * * * *

“Much reliance is also placed by the defendant upon the work carried on for the United States Government by the Department of Terrestrial Magnetism (abbreviated DTM) of the Carnegie Institution, in connection with work on a Magnetograph, in 1943. This work was classified as restricted for security purposes and was stipulated by counsel not to have been declassified until December 15, 1953, which date is subsequent to Heiland’s date of conception and reduction to practice. It is therefore, not to be deemed part of the prior art. * * *” (p. 252)

The Court of Appeals for the Seventh Circuit affirmed both the judgment and the ruling of the Trial Court, saying:

“The statute uses the words ‘known or used.’ This implies that the knowledge and use must be accessible to the public. *Block v. Nathan Ankle Support Co.*, 2 Cir., 9 F.2d 311; *Gillman v. Stern*, 2 Cir., 114 F.2d 28, cert. den. 311, U.S. 718. In the latter case, Judge Learned Hand for the Court, explained the distinction between secret knowledge or use and public knowledge or use.”

Apparently the most recent pronouncement to the effect that prior knowledge within Section 102(a) must be public is in *In re Borst*, (CCPA, decided May 27, 1965)F.2d, 145 USPQ 554. In that case the question arose as to whether a document under secrecy classification by the Atomic Energy Commission was a publication within Section 102(a). In holding that it was not, the Court said:

“Another aspect of the court’s discussion in *Schlittler* [*In re Schlittler*, 43 CCPA 986, 234 F.2d 882] involved the well-established principle that ‘prior knowledge of a patented invention would not invalidate a claim of the patent unless such knowl-

edge was available to the public.' After reaffirming that principle, the court went on to state:

'Obviously, in view of the above authorities, the mere placing of a manuscript in the hands of a publisher does not necessarily make it available to the public within the meaning of said authorities.'

• • • • •

"We shall consider first the public availability aspect of the Schlittler case. Although that portion of the Schlittler opinion is clearly dictum, we think it just as clearly represents the settled law. The knowledge contemplated by section 102(a) must be accessible to the public. In addition to Schlittler and cases cited therein, see, e.g., Minneapolis-Honeywell Regulator Co. v. Midwestern Instruments, Inc., 298 F.2d 36, (7th Cir. 1961); Rem-Cru Titanium, Inc. v. Watson, 152 F. Supp. 282, (D.D.C. 1957).

"In the instant case, Samsel was clearly not publicly available during the period it was under secretary (secrecy) classification by the Atomic Energy Commission. • • •"

Whenever the disclosures of two or more patents are considered collectively or "combined" in making a rejection, it is on the authority of Section 103 and, under Sections 102 and 103, such combination could not have been obvious "to a person having ordinary skill in the art" until such time as the patents to be combined *were all issued and were available to persons skilled in the art; that is, were publicly known. But copending patents are not publicly known nor are they available to those skilled in the art as of their filing dates—they are maintained in strict secrecy within the Patent Office under Section 122 of the Patent Act (supra, p. 3).*

In summary, there are, *inter alia*, two distinct and independent statutory bars to the grant of a patent on an invention:

1. The invention was not new, having been disclosed entirely or with inconsequential variations in an issued patent or printed publication bearing a date before the invention was made (Section 102(a)) or more than one year before a patent application thereon was filed (Section 102(b)). In this case, Respondent does not contend that either of the reference patents cited by the Patent Office discloses the entire Regis invention or that a patent to Regis is barred by the provisions of either of these Sections of the Patent Statutes.

2. While the invention in question was new, the quantum of newness, measured against the "prior art" as defined above, was not sufficient to support the grant of a patent (Section 103). This is the Section of the Patent Statutes on which Respondent relied in the Courts below and in its Brief in Opposition to the Petition herein (p. 2). The controversy arises, therefore, as to whether the term "prior art" as used in Section 103, meaning "what was (publicly) known before", embraces copending patents which were *not publicly known* as of the dates of their filing in the Patent Office but, on the contrary, were maintained in complete secrecy under Section 122 of the Patent Statutes (*supra*, p. 3). This is the gravamen of the question presented on this Petition (*supra*, p. 4).

Unfortunately, some confusion is found in a number of the decisions because the lines of demarcation between the foregoing distinct and different bars to the grant of a patent, based on different theories and on different Sections of the Statute, have not been maintained. Particularly, the term "prior art" has been used loosely and synonymously with "anticipation", a term not found in the Statutes, and with other bars to the grant of a patent, embracing evidence falling within the several subsections of Section 102 and Section 103.

Nevertheless, it is submitted that the better reasoned authorities *have* maintained a proper distinction between the several statutory bars to the grant of a patent and *have* correctly held that a copending patent is *not* competent evidence of the prior art while it is still a secret application in the Patent Office. Only after it issues as a patent does it become a part of the general public knowledge or "prior art".

Thus, *Helene Curtis v. Sales Affiliates* (C.A. 2, 1956) 233 F.2d 148, 156, 158, was an action for a declaratory judgment that a patent owned by defendant on a hair-waving method was invalid. The Court of Appeals, while finding the patent invalid on other grounds, agreed with defendant that the copending patent relied on by plaintiff was not a part of the prior art, saying:

"We think the defendant is right in its insistence that the second Speakman patent, which did not issue until after McDonough's filing date, should not be treated as part of the prior art for purposes of determining the issue of patentable invention in McDonough's claims. *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, 2 Cir., 159 F.2d 379; *Comolite Corp v. Davidovitz*, 2 Cir., 111 F.2d 121; *Stelos Co. v. Hosiery Motor-Mend Corp.*, 2 Cir., 72 F.2d 405. * * *

"Both Speakman's second U. S. Patent and the Evans and McDonough Patent did not go to issue until after the filing date of the patent in suit. On that account they could not be held to constitute part of the prior art or as anticipating patents under 35 U.S.C.A. § 102(a). Nevertheless, they were anticipatory under the doctrine of *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390, now codified in 35 U.S.C.A. § 102(e). *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*,

supra; *Stelos Co. v. Hosiery-Mend Corp.*, supra.
 * * * (pp. 156, 158)

In *Weatherhead v. Drillmaster Supply* (C.A. 7, 1955) 227 F.2d 98, 101, the Trial Court had held that the '217 patent in suit

"* * * does not disclose invention over 413, (an earlier filed copending patent to the same inventor) and that the specific ring disclosed in claim 12 of patent 413 was within the skill of and would have been obvious at the time of the invention claimed in patent 217 to any mechanic skilled in this art. * * *"

The Court of Appeals, while finding the patent invalid for double patenting, that is, for claiming the same invention as the earlier patent to the same inventor, rejected the rationale of the Trial Court saying:

"In *Old Town Ribbon & Carbon Co. v. Columbia R. & C. Mfg. Co.*, 2 Cir., 159 F.2d 379, the same court, in an opinion by the same judge, held that the first of copending patents was *not* prior art as to the others, and that it could be shown to prove a prior inventor but not to show the state of the art for the purpose of determining whether the second patent disclosed invention. This is the position taken in most modern cases in the Courts of Appeals. *B. F. Sturtevant Co. v. Massachusetts Hair & Felt Co.*, 1 Cir., 122 F.2d 900, 913; *Sherwin-Williams Co. v. Marzall*, D.C. Cir., 190 F.2d 606." (emphasis Court's)

For the convenience of the Court, there is repeated in Appendix II to this Brief a list of all Appellate decisions which have been found dealing with this issue since the landmark decision of this Court in *Alexander Milburn v. Davis-Bournonville* (1926) 270 U.S. 390. Prior to the decision of this Court in the *Alexander Milburn* case, the authorities were in such a state of hopeless confusion with

respect to the effect of copending patents that it is not fruitful to pursue them.

With the exception of one decision of the Court of Appeals of the Eighth Circuit, one decision of the Court of Appeals of the Fourth Circuit in 1931, and one decision of the Court of Appeals of the Second Circuit in 1945, the only Appellate decisions holding that a copending patent is a part of the prior art as of its filing date are from the Court of Appeals of the District of Columbia and the Court of Customs and Patent Appeals. It appears that these two Courts have departed from the mainstream of the case law.

Respondent, in its Brief in Opposition to the Petition, urged that this Court, in *Detrola v. Hazeltine* (1941) 313 U.S. 259, had decided the question presented on this Petition. A careful examination of that decision and of the petition and briefs on which the case was submitted shows clearly that *this question was neither presented nor decided in the Detrola case.*

Petitioner's brief in the *Detrola* case discussed (pp. 15-25) a number of reference patents, each of which it alleged individually and completely disclosed the invention defined by the claims there in suit. While that brief did not use the exact term "prior invention", it is clear that each of the reference patents was urged by petitioner in that role. There is no reference whatever to the prior art or to the general state of the art against which an invention not so completely disclosed in any single prior patent or publication is measured to determine whether or not it would have been obvious to one skilled in the art, a requirement of prior case law codified in Section 103.

Respondent's brief in the *Detrola* case (pp. 47-56) met petitioner's attack against the claims in suit on precisely the same ground, that is, urging that none of the reference patents, individually and completely, disclosed the invention defined by the claims in issue.

While the *Detrola* case was decided prior to the enactment of the 1952 Patent Act, it is clear that both parties to that controversy considered the reference patents solely from the basis of individual and complete anticipation of the claims in issue by each of the reference patents and did not raise the question of whether their disclosures could be used collectively to establish the prior art against which the claims should be tested to determine whether the invention was one which would have been obvious to one skilled in the art.

While, in *Detrola*, this Court did group together previously issued patents and copending patents as references and said that "All constituted prior art." (p. 265), this statement is footnoted to the *Alexander Milburn* case, *supra*, which involved solely the issue of prior inventorship (now codified in Section 102(e)), not the question of the quantum of invention over the prior art (Section 103). The intent of this Court in the *Detrola* decision is thus clear—a copending patent can properly be employed in the same manner as in the *Alexander Milburn* case to establish prior invention by another. This is borne out by this Court's actual holding in that case, namely:

"* * * that Wheeler accomplished an old result by a combination of means which, singly or in similar combination, were disclosed by the prior art and that, notwithstanding the fact that he was ignorant of the pending applications which antedated his claimed date of invention and eventuated into patents, *he was not in fact the first inventor*, * * *." (p. 269; emphasis added)

In *Old Town v. Columbia Ribbon* (C.A. 2, 1947) 159 F.2d 379, Judge Learned Hand, a recognized authority on the patent law, rendered his decision less than six years after the *Detrola* case and unquestionably accorded the decision of this Court the respect it was due. Notwith-

standing the *Detrola* case, Judge Hand stated that a copending patent was not within the prior art and could invalidate claims of the patent in suit only on the issue of prior inventorship.

In any event, even if the *Detrola* decision did hold as urged by Respondent in the Courts below, to the extent that it is inconsistent with latest Congressional action, represented by the 1952 Patent Act, it must give way to that Act.

Respondent, in its Brief in Opposition to the Petition, contended that the *Helene Curtis* and *Weatherhead* cases, *supra*, as well as *John Blue v. Dempster Mill* (C.A. 8, 1960) 275 F.2d 668, contain only dicta in support of Petitioners' position that a copending patent is not prior art as of its filing date. A careful review of those decisions does not support Respondent's contention. In *Helene Curtis*, the Trial Court had held that a McDonough patent in suit "lacked patentable invention over" a group of patents constituting the prior art, which included a copending patent to one Speakman. The Court of Appeals explicitly reversed that finding in the excerpt quoted above (p. 15). The fact that the Court held the McDonough patent invalid on other grounds is irrelevant.

In *Weatherhead*, the Trial Court had held that a Kriedel patent in suit did not disclose invention over an earlier copending patent of the same inventor, that is, that the subject matter of the patent in suit would have been obvious to one skilled in the art in the light of the disclosure of that copending patent. The Court of Appeals reversed that holding, saying:

"* * * It is clear, however, that copending applications on which patents are granted to the same inventor must pass *two* tests of validity. They must constitute invention over the prior art, and they must be 'different' from each other in order to avoid double patenting. If double patenting is found,

the later of the two patents is invalid.” (p. 101; emphasis added)

The Court then went on to reverse the holding of the Trial Court that the Kriedel patent had failed to pass the first test but held the patent invalid for failing to pass the second test, that is, on the ground of double patenting. The holding of the Court of Appeals, relied upon by Petitioners (*supra*, p. 16), was *not dictum*.

In *John Blue, supra*, the Court of Appeals of the Eighth Circuit explicitly held that a prior copending patent to Blue was not prior art to the Blue and Johnston patent in suit (which was, therefore, not subject to attack under Section 103) although such copending patent could:

“• • • nevertheless be used as defense material to prove that Blue and Johnston were not the original and first inventors or discoverors of the metering pump described in their patent. • • •” (p. 672)

This was a holding of invalidity based on Section 102(e) (*supra*, p. 2). Again, the ruling of the Court that the copending patent was not in the prior art as of its filing date is an explicit ruling of the Court—not mere dictum.

The mere fact that in each of the foregoing cases “the patent was held invalid on an alternative ground” (Respondent’s Brief in Opposition, p. 6) is irrelevant.

In summary, it is respectfully urged that the copending Wallace et al. patent 2,822,526 (R. 54A) is not, as of its filing date, competent evidence of the “prior art” as that term is used in Section 103 and, therefore, is not available as evidence from which the obviousness of the Regis invention is to be determined. The 1952 Patent Act excludes from the “prior art” referred to in Section 103 all that was not *publicly* known “at the time the invention was made”, that is, at the time of the filing of the Regis application on December 23, 1957 (R. 7A). At that time, the Wallace et al. patent was not *publicly* known.

POINT 2. BY STRAIGHTFORWARD LOGIC, A CO-PENDING PATENT IS NOT, AS OF ITS FILING DATE, COMPETENT EVIDENCE OF THE PRIOR ART

Section 103 (*supra*, p. 3) establishes as the test of whether a patent should be withheld on an invention, the obviousness of the difference between that invention and the prior art to one skilled in the art.

Obviousness is thus a *fact* which must be proved to defeat a patent under Section 103. The Courts have established a number of criteria for showing lack of obviousness:

1. The satisfaction of a long felt want:

Kaakinen et al. v. The Peelers Co. (C.A. 9, 1962)
301 F.2d 170

Reiner v. I. Leon (C.A. 2, 1960) 285 F.2d 501

Tatko Bros. Slate v. Hannon (C.A. 2, 1959) 270
F.2d 571, 573

Kelley et al. v. Coe (C.A. D.C., 1938) 99 F.2d 435

Tietig et al. v. Ladd (D. D.C., 1964) 228 F.Supp.
637.

2. The age of the prior art from which unobviousness is measured:

Reiner v. I. Leon (CA. 2, 1960) 285 F.2d 501

Tietig et al. v. Ladd (D. D.C., 1964) 228 F.Supp.
637.

3. The over-all effort in devising and developing the invention, for example "how many tried to find the way":

Reiner v. I. Leon (C A. 2, 1960) 285 F.2d 501

Welsh Mfg. v. Sunware Prods. (C.A. 2, 1956)
236 F.2d 225, 227

Lyon v. Bausch & Lomb (C.A. 2, 1955) 224 F.2d
530, 535 (cert. den. 350 U.S. 911)

Bussemer et al. v. Artwire Creations (S.D. N.Y.,
1964) 231 F.Supp. 798.

4. The difficulty of the solution ultimately arrived at:

E. J. Brooks v. Stoffel Seals (C.A. 2, 1959) 266 F.2d 841, 843 (cert. den. 361 U.S. 883)

Bussemer et al. v. Artwire Creations (S.D. N.Y., 1964) 231 F.Supp. 798.

5. The proximity between the field from which knowledge was taken and the field where it was applied:

Potts v. Creager (U.S. S.C., 1895) 155 U.S. 597, 606

Bussemer et al. v. Artwire Creations (S.D. N.Y., 1964) 231 F.Supp. 798.

6. The general availability of the means used by the inventor in devising his invention:

Reiner v. I. Leon (C.A. 2, 1960) 285 F.2d 501, 504

Bussemer et al. v. Artwire Creations (S.D. N.Y., 1964) 231 F.Supp. 798.

7. The commercial success of the invention, for example "how immediately was the invention recognized":

Goodyear v. Ray-O-Vac (U.S. S.C., 1944) 321 U.S. 275, 279

Marvel Specialty v. Bell Hosiery Mills (C.A. 4, 1964) 330 F.2d 164.

Ekco Products v. Chicago Metallic (C.A. 7, 1963) 321 F.2d 550

Shumaker v. Gem Mfg. (C.A. 7, 1962) 311 F.2d 273

Reiner v. I. Leon (C.A. 2, 1960) 285 F.2d 501

Baker-Cammack v. Davis (C.A. 4, 1950) 181 F.2d 550

Charles Peckat et al. v. Jacobs (C.A. 7, 1949) 178 F.2d 794

Wahl Clipper v. Andis Clipper (C.A. 7, 1933) 66 F.2d 162, 165.

It seems clear that a copending patent, in the secret files of the Patent Office at the time the Regis invention was made, could not be used to show obviousness under the foregoing principles. Certainly, "knowledge was (not) taken" from a secret patent application (criterion 5). Certainly, such a secret Patent Office application had no "general availability" (criterion 6).

There is simply no logic in the contention that the obviousness of an invention to a man skilled in the art should be measured against secret knowledge unavailable to the public in general and to him in particular. The most that can be decided under such a set of facts is a hypothetical question — if the man skilled in the art *had had* the unavailable knowledge, would the invention in question *then* have been obvious to him. But there is no way of providing a correct answer to such an "iffy" question and the application of Section 103 does not rest upon the answer to such question.

It is submitted that, as a matter of straightforward logic, a copending patent is not, as of its filing date, competent evidence of the prior art.

POINT 3. UNDER THE RULES OF SIMPLE FAIRNESS AND CONSONANT WITH THE PUBLIC INTEREST, A COPENDING PATENT CANNOT BE INCLUDED IN THE PRIOR ART TO SHOW THAT THE REGIS INVENTION WAS OBVIOUS UNDER SECTION 103

One of the handicaps with which a serious worker and inventor is confronted is the legal fiction imputing to him knowledge of all information published or patented anywhere. He is charged with knowledge of the most arcane information, hidden in the most obscure publication in the most remote library in the United States or in a foreign country.

The Statute (Section 102(a), *supra*, p. 2) makes no reference to the general availability of the published knowledge to the inventor or to his actual acquaintance with it but merely denies him a patent if

“the invention was * * * patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant, * * *”

In this instance, the private interest of the inventor is submerged in the public interest. If the statute provided otherwise, it would put a premium upon ignorance. He who read the least and knew the least might be able to get a patent on matters of common knowledge to his more erudite peers. This would obviously *retard* the progress of the useful arts, not promote it, as encouraged by the Constitution and the Patent Laws.

However, to impute to an inventor knowledge hidden in the secret archives of the Patent Office and unavailable to him or to the public in general, is to compound the legal fiction to his detriment and does not serve any public interest.

The situation presented in the *Alexander Milburn* case (*supra*, p. 16), as codified in Section 102(e) (*supra*, p. 2), actually penalizes an inventor on account of such secret knowledge not available to him, but is easily distinguishable. There, but for the rule, a patent could issue to one who actually made an invention *after* the inventor of the copending patent, who could then take away the right of the earlier inventor to practice his own invention, a common law right arising from the creative act of invention. In such a situation, the public interest is not concerned with which of two rival inventors is awarded a patent. However, it becomes necessary to balance two conflicting private interests and simple justice favors the earlier of the two contestants, denying to the later inventor the right to a patent.

But the factual situation of the instant case presents no conflicting interests, private or public. If a patent is granted including the claims in issue, it cannot take away the right of the patentees Wallace et al. or their assignee, Aircraft Armaments, Inc., to continue to manufacture and sell the wave guide shutter described and claimed in their patent (R. 54A); it cannot take away the right of Carlson or his assignee, Bell Telephone Laboratories, to continue to manufacture and sell the attenuator described and claimed in his patent (R. 50A); nor can it take away the right of the public freely to practice the inventions of those patents after their respective dates of expiration. The only restraint which the grant of the claims in issue to Regis can bring upon those parties is to deny them the right to manufacture and sell the microwave switch described and claimed in the Regis application here in issue (R. 9A-15A), a right which neither of those parties ever had, because neither of them made the invention defined by the claims in issue, and which the public would not acquire upon the expirations of their respective patents.

Simple principles of equity and fair play require exclusion from the general fund of public knowledge, known as the prior art, secret knowledge completely unavailable to workers in the art and, therefore, as long as secret, not aiding in promoting the progress of the useful arts. A copending patent falls in that category until it actually issues as a patent and is available to all workers in the art and to the public at large.

CONCLUSION

It is submitted:

1. That by the terms of the Patent Statutes, Patent No. 2,822,526 to Wallace et al. (R. 54A) is not within the prior art as that term is used in Title 35 U.S. Code, Section 103.

2. That since Respondent does not contend that Patent No. 2,822,526 to Wallace et al. alone discloses the invention described and claimed in the Regis application in issue under Title 35 U.S. Code, Section 102(e) and since it does not contend that the Regis invention is described in prior art Patent No. 2,491,644 to Carlson alone under Title 35 U.S. Code, Section 102(a) or Section 102(b), Respondent has not shown any ground for denying the grant of a patent to Regis including the claims in issue.

3. That the Judgment of the District Court and of the Court of Appeals should be vacated and the District Court ordered to enter a judgment pursuant to Title 35 U.S. Code, Section 145, authorizing the Commissioner of Patents to issue Letters Patent to Petitioners on the invention claimed in claims 1, 2, and 3 of the Regis application Serial No. 704,770, as prayed in the Complaint herein.

Respectfully,

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APPENDIX I**SUMMARIES OF THE REGIS INVENTION
AND OF THE DISCLOSURES OF THE
CARLSON PATENT 2,491,644 AND THE
WALLACE ET AL. PATENT 2,822,526****THE REGIS INVENTION**

The Regis application Serial No. 704,770 was filed December 23, 1957, (R. 7A) and describes and claims a Microwave Switch. This is a device for connecting a microwave source such as a radio transmitter to a useful load device such as an antenna. A microwave is a very high frequency radio wave, the Regis specification mentioning a frequency of the order of 9,000 megacycles (9 billion cycles per second).

The problem to which the Regis invention is directed is that, for proper operation of such a microwave transmitter, its output load (impedance) must be maintained approximately constant and matched to the transmitter impedance. Therefore, it is not practicable simply to disconnect the transmitter from its useful load (antenna) as in ordinary circuits (R. 9A). Regis' solution to the problem was, in general, to devise a particular form of dummy load and gradually to make this dummy load effective at the transmitter as the connection to the useful load is gradually made ineffective.

Referring to Figs. 1 and 2 of the Regis drawing (R. 15A), there is shown schematically a microwave transmitter 10, which may be purely conventional, coupled to a microwave antenna 12, also conventional, through a wave guide 11. Such a wave guide physically is in the form of a hollow pipe and conducts microwaves much as an ordinary pipe conducts water. Extending through a longitudinal slot in the guide 11 is an elongated vane 13 which is tapered toward the end facing the transmitter and is of resistance material which has the property of absorbing microwaves and pre-

senting a load to the transmitter. At the remote end of the vane 13 is disposed a highly conductive transverse metal strip 15 which acts completely to block transmission of microwaves through the guide 11.

As the vane 13 and strip 15 are gradually lowered through the slot into the guide 11, the resistance material of the vane absorbs more and more of the energy from the transmitter so that the signal reaching the shorting strip 15 is attenuated. What signal energy does reach the strip 15 is reflected by it back towards the transmitter but, in the process, is further attenuated by the vane 13. Thus, the load on the transmitter is gradually and smoothly diverted from the antenna 12 to the vane 13 and the strip 15 acting as a dummy load, thus avoiding any disruption to the normal operation of the transmitter.

PATENT 2,491,644 — CARLSON (R. 50A)

This patent discloses a piece of laboratory test equipment called an "attenuator" which is calibrated to indicate directly the amount of attenuation which it effects in a microwave signal passing down a hollow wave guide, this indication being given on the calibrated scale 57 (Fig. 5; R. 50A).

Referring to Figs. 1 to 4 of the drawings, (R. 51A) an elongated wave guide 10 has two opposed longitudinal slots 13 and 14 in which is disposed a vane 16 of resistance material mounted on a pivot shaft 15. The Carlson invention resides in the particular configuration of the vane 16 so that equal increments of angular movement of the vane 16 produce equal increments of attenuation, that is, the attenuation varies linearly with the angular movement of the vane. With such an arrangement, the scale 57 (Fig. 5) is uniform, facilitating laboratory measurements.

Carlson was not confronted with the problem of disconnecting the load from a microwave transmitter and, in fact,

his attenuator cannot effect disconnection of his output from his input because his construction lacks the shorting strip at the remote end of the resistance vane.

PATENT 2,822,526 — WALLACE ET AL. (R. 54A)

This patent discloses what is termed a "shutter" for interrupting the flow of microwave energy through a wave guide. In the arrangement of Figs. 1 and 2 (R. 54A), a wave guide 1 of rectangular cross-section has a slot 7 in its lower wall. Mounted adjacent the slot 7 is a rotatable semi-cylindrical block 14 of resistance material of dimensions such that when it is turned through an angle of 180° from that shown in the figures, it completely blocks the wave guide channel and absorbs the greater portion of the microwave energy flowing through the guide.

The construction of Figs. 3 and 4 of the Wallace et al. patent (R. 55A) is similar except that the block 19 of resistance material is of a quarter-cylindrical shape and, when the shutter is in closed position, a portion 26 of the metallic mounting for the block 19 extends across the wave guide, producing some shorting and reflecting effect on the microwave energy passing through the block 19.

While the Wallace et al. shutter secures results generally similar to that achieved by the Regis invention, its construction is essentially different from that described and claimed in the Regis application. The claims here in issue (R. 33A) define a microwave switch including an attenuating vane of resistance material tapered toward the source of energy in combination with a highly conductive strip at the remote end of the vane.

APPENDIX II

**DECISIONS OF APPELLATE COURTS SINCE
ALEXANDER MILBURN v. DAVIS-BOURNONVILLE
(1926) 270 U. S. 390 DEALING WITH THE RELATION
OF COPENDING PATENTS TO THE PRIOR ART**

In each of the following cases, the Appellate Court has held that a copending patent is *not* embraced within the prior art as of its filing date but only as of its issue date:

Decisions After the 1952 Patent Act:

- Weatherhead v. Drillmaster Supply* (C.A. 7, 1955)
227 F.2d 98
Helene Curtis v. Sales Affiliates (C.A. 2, 1956)
233 F.2d 148
John Blue v. Dempster Mill (C.A. 8, 1960) 275
F.2d 668.

Decisions Before the 1952 Patent Act:

- In re Spencer* (CCPA, 1931) 47 F.2d 806
Stelos Co. v. Hosiery Motor-Mend (C.A. 2, 1934)
72 F.2d 405
In re Youker (CCPA, 1935) 77 F.2d 624
Hazeltine Corp. v. Coe (C.A. D.C., 1936) 85 F.2d
558
In re Walker et al. (CCPA, 1938) 99 F.2d 976
Comolite v. Davidovicz (C.A. 2, 1940) 111 F.2d 121
Old Town v. Columbia Ribbon (C.A. 2, 1947) 159
F.2d 379
Conmar v. Universal Slide (C.A. 2, 1949) 172 F.2d
150
Permo v. Hudson-Ross (C.A. 7, 1950) 179 F.2d 386
Industrial Wire Cloth v. United Specialties (C.A.
6, 1951) 186 F.2d 426.

Thus, the Courts of Appeals of the Second, Sixth, Seventh, and District of Columbia Circuits and the Court

of Customs and Patent Appeals have held that a copending patent *is not* embraced within the prior art as of its filing date.

In addition to the decisions of the Courts below in the instant Action, the following decisions of the Federal Appellate Courts have held oppositely:

Decisions After the 1952 Patent Act:

- Syracuse v. H. Daust* (C.A. 8, 1960) 280 F.2d 377
- In re Gregg* (CCPA, 1957) 244 F.2d 316
- In re Kander* (CCPA, 1963) 312 F.2d 834
- In re Zenitz* (CCPA, 1964) 333 F.2d 924
- In re Harry* (CCPA, 1964) 333 F.2d 920.

Decisions Before the 1952 Patent Act:

- Denaro v. Maryland Baking* (D. Md., 1930) 40 F.2d 513 (Affirmed *per curiam* (C.A. 4, 1931) 40 F.2d 1074)
- Minnesota Mining v. Coe* (C.A. D.C., 1938) 100 F.2d 429 (cert. den. 306 U.S. 662)
- L. Sonneborn Sons v. Coe* (C.A. D.C., 1939) 104 F.2d 230
- Dyer v. Coe* (C.A. D.C., 1941) 125 F.2d 192
- Western States v. S. S. Hepworth* (C.A. 2, 1945) 147 F.2d 345
- In re Seid* (CCPA, 1947) 161 F.2d 229
- Sherwin-Williams v. Marzall* (C.A. D.C., 1951) 190 F.2d 606.

Thus, the Courts of Appeals of the Fourth and the Eighth Circuits and the later decisions of the Court of Appeals of the District of Columbia Circuit and the Court of Customs and Patent Appeals have adopted the rule that a copending patent *is* competent evidence of the prior art as of its filing date.